

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/825,972

Art Unit: 2617

Filed: 04/16/2004

Confirmation No.: 8222

Appellants:

Examiner: Muthuswamy Ganapathy  
Manoharan

ANDREW MICHAEL ALLEN et al.

Title: METHOD AND APPARATUS FOR DYNAMIC GROUP ADDRESS  
CREATION

Docket No.: 291010-00036

Confirmation No. 8222

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**REPLY BRIEF**

November 13, 2009

Mail Stop Appeal Brief - Patents  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, V.A. 22313-1450

Dear Sir/Madam:

This Reply Brief is submitted pursuant to the Examiner's Answer issued by the U.S. Patent and Trademark Office on September 16, 2009, and in support of the appeal from the final rejection(s) set forth in the Office Action mailed on September 30, 2008. In the initial portion of the Answer the Examiner has repeated the rejections and associated reasoning as set forth in the Final Office Action. The Appellants rely upon the specific arguments set forth in the Appeal Brief as a response to those rejections. The remarks below relate primarily to the "Response to Argument" portion of the Answer starting at page 15.

**The undersigned believes there to be no fee due as the payment of the Appeal Brief fee, in the amount of \$540.00, was previously paid with the initial Appeal Brief on March 30, 2009. Please charge any additional fee or credit any overpayment to Eckert Seamans Cherin & Mellott, LLC Deposit Account No. 02-2556.**

## Argument

**Rejection under 35 U.S.C. 102(e) of Claims 65, 68-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114, 116 and 117 over *Torvinen* (U.S. Patent Publication No. 2005/0113123).**

***Torvinen fails to teach or suggest publishing information about one or more particular users of respective mobile stations to the communications network.***

The Examiner again alleges on page 15 of the Examiner's Answer that *Torvinen* teaches the claimed publishing information about one or more particular users of respective mobile stations to the communications network. The Appellants maintain that the Examiner is incorrect.

With respect to the claimed publishing information about one or more particular users of respective mobile stations to the communications network, the Examiner in the Examiner's Answer again points to paragraph 0068 of *Torvinen*, and now points to paragraphs 0013 and 0015. The Examiner again points to a mishmash of unrelated features in *Torvinen* with respect to the claimed published information and ignores the context of the term as defined and claimed in the present application. Paragraph 0068 discusses service parameters defined by organization terminal 402, which represents such location based group formation criteria such as region of interest, session interval, and mode of contact for participants. Hence, the service parameters of *Torvinen* are explicitly described as being defined by the organization terminal 402, and cannot be the same as the claimed **published information about one or more particular users of respective mobile stations to the communications network**. With respect, the Examiner's position is simply not logical. How could service parameters defined by a single organizational terminal (*i.e.*, in *Torvinen*) be the same as the claimed published information that comes from multiple respective mobile stations and concerns the users of those stations? The claimed subject matter and the system of *Torvinen* use completely different approaches to group formation and the two approaches are not analogous.

The Examiner then points to paragraph 0013 of the summary section of *Torvinen* that determines potential group members to invite to a group session based on

location/proximity information and the technical capabilities determined to be necessary to engage in the group session as determined by the organizing terminal.

Again, it is submitted that the Examiner cannot point to multiple features in *Torvinen* for the purpose of showing the claimed publishing information about one or more particular users of respective mobile stations to the communications network, in the hopes that one of these features will “stick” under appeal. This approach neither advances the prosecution of the case, nor provides the Appellants with the proper examination to which it is entitled.

Finally, the Examiner now points to paragraph 0015 of *Torvinen*, which discusses “receiving content from the wirelessly coupled organizing terminal to share with participating members of the group session.” The Appellants have some difficulty following the Examiner’s logic here, but the Examiner appears to assume that the “content” discussed in paragraph 0015 of *Torvinen* is the same as the “service parameters” discussed in paragraph 0068 of *Torvinen* and then concludes that the claimed published information is taught by *Torvinen*. However, the Examiner does not even allege that the “content” discussed in paragraph 0015 of *Torvinen* is the same as the “service parameters” discussed in paragraph 0068, nor is such equivalence suggested by *Torvinen*. In fact, the Examiner does not appear to make any attempt to relate the subject matter of paragraph 0015 of *Torvinen* with the subject matter of paragraph 0068 of *Torvinen*. Therefore, the Examiner’s rejection in this regard is simply incomplete and not supported by the text of *Torvinen*.

The Appellants maintains that the claimed **publishing information about one or more particular users of respective mobile stations to the communications network**, when properly construed in the context of the claim language of claim 65 is neither taught nor suggested by *Torvinen*. The published information is further qualified in claim 65 where the at least one rule is **defined by criteria comprising the published information about respective users of mobile stations and is received in association with a group address**. The group is then **dynamically populated** with members having published information that matches the published information criteria of the at least one rule. All of the qualifying language of claim 65 must be given proper consideration when considering whether *Torvinen* teaches the claimed features. It is submitted that the

Examiner has always ignored the proper context of the claimed features during examination of this application.

***The meaning of “published information.”***

At page 15 of the Appellants’ Appeal Brief, the Appellants submitted that location information, as that term is used in *Torvinen*, is a term of art which would be readily understood by a skilled worker in the industry. “Location information” is information about the actual location of the mobile station that is determined, verified, and maintained by the communication network, for example by communications between the mobile device and local base stations, etc. Published information, in contrast, is information published by a mobile station on behalf of a user to the communication network, thereby making such information available to other users to view.

The Examiner responds at page 17 of the Examiner’s Answer by alleging that the Appellants are trying to add limitations to the claim language not recited in the claims. It is apparent that the Examiner must be alleging that the Appellants are trying to add “thereby making such information available to other uses to view” as a feature of claim 65. To the contrary, the explanation of “published information” provided above is entirely consistent with the plain English meaning of the word “published.”

For example, dictionary.com, on October 26, 2009, defines publish as:

1. to issue (printed or otherwise reproduced textual or graphic material, computer software, etc.) for **sale or distribution to the public**;
2. to **issue publicly** the work of: Random House publishes Faulkner.
3. to **announce** formally or officially; **proclaim**; **promulgate**.
4. to **make publicly or generally known**.
5. Law. to **communicate** (a defamatory statement) to some person or persons other than the person defamed (emphasis added).

Therefore, based on the plain language meaning of the word “publish,” the Appellants are unable to follow the Examiner’s allegation that the claimed published information could possibly not be available for other users to view, as the Examiner seems to be alleging. If the published information was not available

for other users to view, it would not meet the definition of published information, according to its plain English meaning, outlined above.

### ***Conclusion***

Appellants maintain that *Torvinen* fails to teach or suggest all of the features recited by Claim 65, in the manner described by Claim 65. For this reason, it is submitted that Claim 65 recites patentable subject matter and the rejection should be reversed.

Independent Claims 94, 103, 104, 113, and 114 were also rejected on the same basis and are patentable for the same reasons. The remaining claims are dependent on Claims 65, 94, 103, 104, 113, and 114 and are patentable for the same reasons.

The Board of Appeals is thus respectfully asked to reverse the rejections of Claims 65, 94, 103, 113, 114, and the respective dependent claims under 35 U.S.C. § 102(e).

### **Rejections under 35 U.S.C. § 103(a)**

#### ***Amir as Non-Analogous Art***

Appellants argued in their Appeal Brief that *Amir* constitutes non-analogous art to *Torvinen*. The Examiner responds in the Examiner's Answer by alleging that the Appellants have admitted that *Amir* is analogous art because *Amir* was cited by the Appellants in Appellants' Information Disclosure Statement of September 27, 2004. With respect, the Examiner's position doesn't make sense. The Appellants' Information Disclosure Statement of September 27, 2004 specifically stated, "This statement is filed solely for the purpose of complying with the pertinent rules of the Office and is not intended to be a substitute for an independent evaluation by the Examiner of the art cited or an independent search by the Examiner. No representation of any nature is made or intended by the filing of this statement."

Further, Appellants' Information Disclosure Statement of September 27, 2004 does not cite or even mention the *Torvinen* reference. Appellants are unable to understand how the Information Disclosure Statement could possibly admit that *Amir* is

analogous art to *Torvinen*, as the Examiner is contending. The Appellants maintain that *Amir* and *Torvinen* are non-analogous art, as argued in Appellants' Appeal Brief.

### ***Hindsight***

The Examiner again cites to *In Re McLaughlin* with regards to the use of hindsight and states that, "But so long as it takes into account knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Appellants' disclosure, such a reconstruction is proper."

The Appellants take exception with this statement in that it is incomplete. The Examiner must still provide proper motivation, supported by an articulated reasoning, as to why one skilled in the art would combine the references in the manner proposed by the Examiner, all of which must form part of the Examiner's *prima facie* obviousness rejection. The Appellants have repeatedly submitted that the Examiner has failed to properly make out the rejections and that the rejections are therefore almost entirely based on the use of hindsight reasoning, which is improper.

Because the Examiner appears to be admitting using hindsight in his analysis, the Appellants submit that the use of hindsight in the present rejections is improper because the Examiner is relying almost entirely on hindsight reasoning without providing a proper basis for the obviousness rejections, as discussed below.

### ***The Examiner Has Not Properly Supported the 35 U.S.C. § 103 Rejections and has Failed to Establish a prima facie Cases of Obviousness.***

#### ***(a) The Examiner has not Properly Supported the 35 U.S.C. § 103 Rejections***

As argued in the Appeal Brief, MPEP § 2141 states, "Office personnel **must** therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include **explicit findings** as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. **Factual findings** made by Office personnel **are the necessary**

**underpinnings to establish obviousness.”** (Emphasis added). MPEP § 2142 notes that, “[t]he Federal Circuit has stated that ‘**rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning** to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).” (Emphasis added). MPEP § 2143 states, “The **key** to supporting any rejection under 35 U.S.C. 103 **is the clear articulation of the reason(s) why the claimed invention would have been obvious.**” (Emphasis added).

In its various responses, the Appellants have repeatedly asked the Examiner to provide sufficient basis for the obviousness rejections. The Examiner has continuously failed to address the substance of Appellants’ arguments; namely, that a rejection under 35 U.S.C. § 103(a) and under *KSR International* requires an “articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness” and that articulated reasoning must be explicit. As stated in *KSR International*, **a mere conclusory statement cannot sustain a determination of obviousness.** Just to be clear, the Appellants are not attempting to rebut the Examiner’s prima facie case for obviousness, as the Examiner has failed to present a prima facie case for obviousness. Thus, the burden of proof is still upon the Examiner. That is, until the Examiner has presented a proper *prima facie* case for obviousness, the burden of proof is still with the Examiner. MPEP §2142.

The Examiner purports to address the Appellants’ arguments in the Examiner’s Answer beginning at page 19. However, the Appellants are again unable to find any more detail in the Examiner’s obviousness rejections than was offered in the various office actions to date. The Examiner again appears to be repeating the same text to support the obviousness rejections that was offered in the various office actions to date. In most cases, the Examiner’s justification for rejecting the claims as obvious amounts to a recitation of the Appellants’ own claim language combined with a single conclusory statement that the claim is obvious over the cited references. Therefore, it is submitted that the Examiner has failed to make proper *prima facie* obviousness rejections and the Appellants remain in the position of having to respond to obviousness rejections to which no proper basis is provided.

***Claims 94-102 and 103-112 Have Not Been Properly Examined and the Examiner has Failed to Establish a prima facie Case of Obviousness for Claims 94-102 and 103-112***

It is noted that the Examiner simply groups Claims 94-102 and 103-112 into one large omnibus rejection, at page 14 of the Office Action of September 30, 2008. The Examiner has the burden of establishing a *prima facie* case of obviousness with respect to each of the claims. Claims 94-102 and 103-112 contain variations compared to the other claims, yet the Examiner has made no attempt to properly examine Claims 94-102 and 103-112, as required.

For example, Claim 104 explicitly recites that the first step in the process that the mobile device is configured to perform involves transmitting, to a server adapted to create and manage a group of mobile stations information to be published to the communications network about one or more particular users of respective mobile stations. The various cited references do not teach or suggest this feature. As such, the rejection is again improper and should be withdrawn.

Further yet, it is difficult to even determine what the Examiner's rejections of Claims 94-102 and 103-112 are. The Examiner states that Claims 94-102 are rejected for the same reasons as Claims 65-73, yet Claim 65 is rejected under 35 U.S.C. § 102(e) over *Torvinen* while Claims 66 and 67 appear to be rejected under 35 U.S.C. § 103(a) over *Torvinen* in view of *Amir*. The same problem exists for the Examiner's rejection of claims 103-112. The Appellants further submit that these rejections should be reversed for lack of clarity.

The Examiner fails to address this problem at page 27 of the Examiner's Answer by again alleging that "claims 94-102 and 103-112 are not distinctly different from other claims examined," despite the fact that the Appellants have provided explicit examples of how the language of Claims 94-102 and 103-112 differs from the other claims, which has been reproduced above.


The Appellants still have not received proper rejections of Claims 94-102 and 103-112 that would enable the Appellants to respond to the Examiner's rejections in any meaningful way.



**Conclusion**

It is submitted that Claims 65-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114, 116 and 117; Claims 72 and 73; Claims 76-78; Claim 85; Claim 86; Claims 89-92; and Claim 93 are patentable over the prior art. Therefore, it is requested that the Board reverse the Examiner's rejections of Claims 65-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114, 116, 72, 73, 76-78, 85, 86, 89-92 and 93 and remand the application to the Examiner for the issuance of a Notice of Allowance.

Respectfully submitted,



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